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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/773,857      | 02/06/2004  | Mark E. Ogram        | 1414M.1             | 7228             |

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| EXAMINER |
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KIM, PAUL

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2161

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 12/29/2006 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/773,857 | <b>Applicant(s)</b><br>OGRAM, MARK E. |  |
|                              | <b>Examiner</b><br>Paul Kim          | <b>Art Unit</b><br>2161               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This Office action is responsive to the following communication: Amendment filed on 10 October 2006.

2. Claims 1-13 and 17-19 are pending and present for examination. Claims 1, 8 and 13 are independent.

#### *Response to Amendment*

- 3. Claims 14-16 have been cancelled.
- 4. Claims 1, 5-8, 12-13, and 17-19 have been amended.
- 5. No claims have been added.

#### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-13 and 17-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (U.S. Patent No. 6,401,118, hereinafter referred to as THOMAS), filed on 13 August 1998, and issued on 4 June 2002, in view of Barney (U.S. Patent No. 6,289,341, hereinafter referred to as BARNEY), filed on 26 June 1998, and issued on 11 September 2001, and in further view of Official Notice.

8. **As per independent claims 1-4, 8-11 and 13**, THOMAS, in combination with BARNEY and Official Notice, discloses:

An Internet system comprising:

- a) a communication network for remote computers {See THOMAS, Figure 1};

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- b) a host computer providing host data via said communication network to remote computers, said host data identified by a unique host address {See THOMAS, C6:L33-37, wherein this reads over "a user, on one of the web client"};
- c) a searching computer having a unique user indicia contained therein, said searching computer, in response to directions from a user of said searching computer, programmed to obtain data originating from a host computer with an associated host address {See THOMAS, C2:L26-28, wherein this reads over "contact information for each registrant of the offending URL's. The method then produces a report listing the offending URL's and the score for each of the URL's"} and communicate the unique host address {See BARNEY, C4:L12-16, wherein this reads over "the site database contains Uniform Resource Locators (URLs) or Internet Protocol addresses of the sites"}, and said unique user indicia {See BARNEY, C1:L64-C2:L4, wherein this reads over "an IP database containing IP indicia to be compared"}, via said communication network to a remote computer; and,
- d) a reporting computer connected to said communication network, said reporting computer having
  - 1) a data base of addresses {See THOMAS, C2:L43-46, wherein this reads over "[t]he system also includes a file system for storing pages from each of the offending URL's and a relational database for allowing the IPIS to perform queries of the pages in order to produce a report"},
  - 2) memory means for storing a user identification therein {See THOMAS, C5:L63-67, wherein this reads over "[t]he physical file system, in a preferred embodiment of the present invention, is any physical memory device that includes a storage media and a cache"}, and,
  - 3) is programmed to:
    - A) receive an inquiry having a user identification corresponding to said unique user indicia and an inquiry address corresponding to said host address from said searching computer, and {See THOMAS, C4:L53-56, wherein this reads over "a Web server is a server process running at a Web site which sends out web pages in response to Hypertext Transfer Protocol (HTTP) request from remote browsers"};
    - B) if said inquiry address does not correspond to any address within said data base,
      - 1) store said inquiry address in said data base {See BARNEY, C4:L12-16, wherein this reads over "the site database contains Uniform Resource Locators (URLs) or Internet Protocol addresses of the sites"}, and,
      - 2) provide a reward to a user associated with said user identification.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified THOMAS to include a database of addresses, and to include the searching

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computer having a unique user indicia contained therein, and communicating the unique user indicia as reporter identification.

Additionally, the Examiner takes Official Notice that a reward (i.e. compensation) is provided to the user associated with the reporter identification for the performed search (i.e. services rendered), since the identification is used to identify a specific user, wherein the reward can be in a form of cash, credit on a credit card (e.g. a gift card), and any other form of monetary compensation such as a check.

One of ordinary skill in the art would have been motivated to do this modification because having a database of addresses would enable the searching computer to perform a more precise search on only the sites identified by the addresses contained in the database, and the searching computer having a unique user indicia contained therein, and communicating the unique user indicia as reporter identification would enable the host computer to identify the reporting agent who has reported an intellectual property infringement issue, allowing for the rewarding of the user associated with the reporter identification.

9. **As per dependent claims 5, 12 and 17, THOMAS, in combination with BARNEY and Official Notice, discloses:**

The Internet system according to claim 1,

a) wherein said reporting computer further includes:

1) image data stored within said memory means {See THOMAS, C2:L37-46, wherein this reads over "a file system for storing pages from each of the offending URL's"; and C6:L63-67, wherein this reads over "the URL's within the preliminary set contains files, those files may contain potentially infringing material (e.g., a "\*.mp3" music file, or a "\*.gif" or "\*.jpg" image file)"}; and,

2) means for communicating said image data to a requesting computer {See THOMAS, C2:L37-46}; and,

b) wherein said searching computer includes means for requesting said image data from said reporting computer {See THOMAS, C6:L33-37, wherein this reads over "[t]he search criteria, as explained in detail below in Section V, are customized according to a particular client's intellectual property infringement"}.

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10. **As per dependent claims 6 and 18**, THOMAS, in combination with BARNEY and Official

Notice, discloses:

The Internet system according to claim 5, wherein said searching computer includes means for displaying said image data from said reporting computer {See THOMAS, C9:L57-61, wherein this reads over "images found directly on the Web page and that automatically plays or is displayed when the page is browsed"}.

11. **As per dependent claims 7 and 19**, THOMAS, in combination with BARNEY and Official

Notice, discloses:

The Internet system according to claim 1,

a) further including a client computer connected to said communication network {See THOMAS, C6:L33-34, wherein this reads over "one of the web client [202] workstations"}; and,

b) wherein said reporting computer includes,

1) means for communicating a suspect image from said host computer at said inquiry address {See THOMAS, Figure 1; and C9:L57-61, wherein this reads over "images found directly on the Web page and that automatically plays or is displayed when the page is browsed"}; and,

2) means for communicating said suspect image and said inquiry address to said client computer via said communication network {See THOMAS, Figure 1; and C9:L57-61, wherein this reads over "images found directly on the Web page and that automatically plays or is displayed when the page is browsed"}.

### ***Response to Arguments***

12. Applicant's arguments filed 10 October 2006 have been fully considered but they are not persuasive.

a. **Applicant's Arguments:**

As per claims 1-19, Applicant asserts the argument that Thomas and Barney stand in "stark contrast to the present invention which employs a human user to identify and report the sought after material" (Amendment, pages 8-9).

Additionally, Applicant asserts the argument that there is no need to reward the computers with a reward (Amendment, page 9).

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Additionally, Applicant asserts the argument that Thomas and Barney teach away from the concept of "using a human browser" (Amendment, page 9).

b. **Response to Arguments:**

As per claims 1-19 and Applicant's assertion that Thomas and Barney stand in "stark contrast to the present invention which employs a human user to identify and report the sought after material," the Examiner respectfully disagrees. One of ordinary skill in the art at the time the invention was made would properly recognize that "directions from a user of said searching computer, programmed to obtain data originating from a host computer," as recited in line 6 of claim 1, given the broadest reasonable interpretation, would encompass the entry of search parameters and keywords as found in Thomas and Barney. The entry of the search parameters and keywords would permit the searching computer, via a search engine, to "obtain data originating from a host computer." Furthermore, said broadest reasonable interpretation would further encompass the prior art of search engines which is commonly and widely known to one of ordinary skill in the art.

Additionally, as per Applicant's assertion that Thomas and Barney stand "in stark contrast to the present invention which employs a human user to identify and report the sought after material," the Examiner respectfully disagrees. Applicant is directed to the prior art references, Thomas and Barney, which disclose the employing of a human user in performing queries and identifying the desired data.

Additionally, as per Applicant's assertion that there is no need to reward the computers with a reward, the Examiner respectfully disagrees. Applicant is directed to page 3 of the Office action dated 21 September 2006, wherein the Examiner takes Official Notice that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a reward (i.e. compensation) to the user associated with the reporter identification for the performed search (i.e. services rendered)." It would have been obvious to one of ordinary skill in the art at the time the invention was made that compensation would be provided for services

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rendered, particularly the performing of a search. It is further noted that the claim language, line 16-19 of claim 1, is optionally recited since the user is provided a reward "if said inquiry address does not correspond to any address within said database." Therefore, the optionally recited limitation is not granted patentable weight since the limitation may or may not occur.

Additionally, as per Applicant assertion that Thomas and Barney teach away from the concept of "using a human browser," the Examiner respectfully disagrees. Applicant is directed to the prior art references, Thomas and Barney, which disclose the employing of a human user in performing queries and identifying the desired data. Therefore, the prior art certainly discloses the use of a "human browser" since a user is the entity performing the search.

For the aforementioned reasons stated above, the rejections of claims 1-13 and 17-19 under 35 U.S.C. 103(a) are sustained.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Kim. The examiner can normally be reached on M-F, 9am - 5pm.

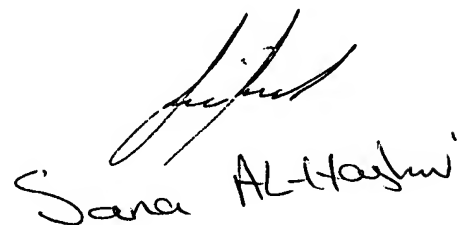


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Sara Al-Hayawi